

REMARKS/ARGUMENTS

Claims 1 to 19 are pending in this application. Claims 12 to 19 were withdrawn due to an earlier restriction requirement and Claim 1 was amended.

Claims 1 to 12 were rejected under 35 U.S.C. 112, first paragraph, for not enabling the claimed invention. The Office Action contends that the large group of compounds embraced in the definition of Ar₁, Ar₂ and ZT may absorb UV which would put the compounds outside the lower UV absorbance mentioned in the specification. Applicants respectfully traversed this rejection.

As discussed in MPEP 2164.01, the test for enablement is whether, based on the disclosure in the application, one skilled in the art can make or use the claimed invention without undue experimentation. Applicants have supplied sufficient information on pages 13-15 and the working examples on how to make the claimed compounds. Applicants also have provided sufficient information on pages 15 to 22 on how to use the compounds claimed in this invention. Therefore, Applicants have fulfilled the test for enablement.

"In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." MPEP 2164.04 (citing *In Re Wright*, 27 USPQ2d, 1510, 1513 (Fed Cir. 1993)). Examiner should indicate why the claimed compounds can not be made or used based on the information supplied in the application.

The Office Action contention that the claimed invention is not enabled because there may be some groups defined in Ar₁, Ar₂ and ZT which may affect the lower UV regions described in the specification is irrelevant. There is no UV range recited in any of the claims. Applicants specifically reject any implication or suggestion that the claimed invention has any UV wavelength limitation. It is incorrect to incorporate descriptions in the specification as limitations in the claim.

However, in order to expedite prosecution, and only to expedite prosecution, Applicants have, in the amendment, removed some groups, as suggested by the Examiner, in Ar₁, Ar₂ and ZT that in Applicants' opinion may have some effect on the UV absorbance of the claimed 2-hydroxynaphthyl-triazine compounds. Again, it is incorrect to limit any of the claims compounds to absorb in any specific wavelength because there is no wavelength limitation recited, either implicitly or explicitly, in the claims.

Applicants would like to comment on a statement in the Office Action concerning color and solubility. The Office Action contends that the two declarations require that the claimed compounds be colorless and have desired solubility. That statement is incorrect. The declarations were only used to compare the closest prior art tris(2-hydroxy naphthyl)-

triazine compounds, as cited by the Examiner, to the claimed mono(2-hydroxynaphthyl)-triazine compounds in order to rebut the obviousness rejection of Claims 1 to 6 (Claims 7 to 11 were not rejected for obviousness). The color and solubility parameters were only used for that rebuttal and should not be included as limitations in the claims. Applicants specifically reject any implication or suggestion that the claimed invention has any color or solubility limitation.

Applicants would also like to comments on a statement in the Office Action concerning the working examples. The Office Action contends that only working examples related to 2,4-bis(2,4-dimethylphenyl)-6-hydroxynaphthyl-triazine were supplied. This is incorrect. For example, Working Examples 1 and 2 are not derived from 2,4-dimethylbenzene.

In summary, The Office Action incorrectly rejected claims 1 to 12 for lacking enablement based on limitations not recited in the claims. Applicants has supplied more than adequate information regarding how to make and use the claimed invention based on pages 13 to 32 of the present application. In addition, in order to expedite prosecution, Applicants have modified the definition of Ar₁, Ar₂ and ZT to remove some groups that may have some effect on UV absorbance.

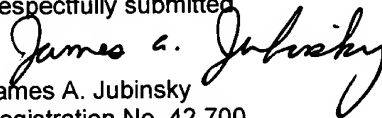
Accordingly, it is believed that pending claims 1 to 11 are in condition for allowance and an early notification of such allowance would be appreciated.

Applicants would like to remind the Examiner that claims 12 to 19 have not been cancelled from this Application. If claims 1 to 6 are allowable, Applicants respectfully request that method claims 12 to 14 be rejoined under MPEP §821.04 since the all the product claims are allowable and the non-elected method claims include all the limitations of the product claims.

In addition, Applicants also would request rejoinder of composition claims 15 to 19 since if products claims 1 to 11 are novel and non-obvious, any claims that wholly depend on claims 1 to 11 would also be novel and non-obvious. Since claims 15 to 19 wholly depend on claims 1 to 11, they should be rejoined.

No fee is believed due for the submission of this response. Should any fee be required, please charge Deposit Account No. 03-4083.

Respectfully submitted


James A. Jubinsky
Registration No. 42,700

Cytec Industries Inc.
Patent Law Department
1937 West Main Street
P.O. Box 60
Stamford, CT 06904-0060
Telephone: (203) 321-2913
Facsimile: (203) 321-2971